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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/553,449	04/19/2000	Nancy Bryant	CITI0218	3842
27510 7590 03/30/2007 KILPATRICK STOCKTON LLP 607 14TH STREET, N.W. WASHINGTON, DC 20005			EXAMINER SUBRAMANIAN, NARAYANSWAMY	
			ART UNIT	PAPER NUMBER
			3692	
SHORTENED STATUTORY PERIOD OF RESPONSE		MAIL DATE	DELIVERY MODE	
3 MONTHS		03/30/2007	PAPER	

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

<b>Office Action Summary</b>	<b>Application No.</b> 09/553,449	<b>Applicant(s)</b> BRYANT ET AL.	
	<b>Examiner</b> Narayanswamy Subramanian	<b>Art Unit</b> 3624	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 08 March 2006.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-28 is/are pending in the application.
- 4a) Of the above claim(s) 28 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-27 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

1. This office action is in response to applicants' communication filed on March 8, 2006. Election of invention I pertaining to claims 1-27 with traverse is acknowledged by the examiner. Claim 28 is withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention. Applicants are respectfully advised to cancel the non-elected claim in response to this office action. Claims 1-27 have been examined. The response to amendment and rejections are stated below.

#### ***Response to Amendment***

2. In response to Applicant's assertion that search and examination of the entire application can be made without serious burden, the examiner respectfully disagrees. The case for the inventions being distinct and independent was already made in the last office action. Also the inventions require separate searches. Unlike other art units where the searches are primarily focused on patent literature, in business methods a bulk of the search is in non-patent literature, which imposes a serious burden on the examiner if two or more inventions have to be searched. For these reasons and reasons cited in the last office action the restriction of inventions is maintained.

#### **Claim Rejections - 35 USC § 101**

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4. Claims 1-27 are rejected under 35 U.S.C. § 101 because the claimed invention is directed to non-statutory Subject matter.

35 USC 101 requires that in order to be patentable the invention must be a "new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof" (emphasis added).

Claims 1-27 are drawn to "a method and system for a user to obtain international account products access on a network". As such the claimed invention is directed to a judicial exception to 35 U.S.C. 101 (i.e., an abstract idea, natural phenomenon, or law of nature) and is not directed to a practical application of such judicial exception because the claims do not require any physical transformation and the invention as claimed does not produce a useful, concrete, and tangible result. The limitations of the method and the system including the last step of "allowing the user at the local terminal to perform said selected transaction interactively in said selected language via the host processor" do not produce any real world useful result. Allowing the user to perform said selected transaction does not mean that the selected transaction is actually performed. Allowing merely provides the ability to the user to perform a transaction but does not necessarily result in the user performing the transaction. Hence there is no real world useful result produced by implementing the steps of the claimed invention.

The Court of Appeals for the Federal Circuit issued opinions in *State Street Bank & Trust Co. v. Signature Financial Group Inc.*, 149 F. 3d 1368, 47 USPQ2d 1596 (Fed. Cir. 1998) and *AT&T Corp. v. Excel Communications, Inc.*, 172 F.3d 1352, 50 USPQ2d 1447 (Fed. Cir. 1999). These decisions explained that, to be eligible for patent protection, the claimed invention as a whole must accomplish a practical application. That is, it must produce a "useful, concrete and tangible result." *State Street*, 149 F.3d at 1373-74, 47 USPQ2d at 1601 02. To satisfy section 101 requirements, the claim must be for a practical application of the § 101 judicial exception, which

can be identified in various ways: (a) The claimed invention “transforms” an article or physical object to a different state or thing. (b) The claimed invention otherwise produces a useful, concrete and tangible result, based on the factors discussed below.

The USPTO’s official interpretation of the utility requirement provides that the utility of an invention has to be (i) specific, (ii) substantial and (iii) credible. See MPEP § 2107.

The tangible requirement does require that the claim must recite more than a § 101 judicial exception, in that the process claim must set forth a practical application of that § 101 judicial exception to produce a real-world result. Benson, 409 U.S. at 71-72, 175 USPQ at 676-77 (invention ineligible because had “no substantial practical application”). The limitations of the method and the system including the last step of “allowing the user at the local terminal to perform said selected transaction interactively in said selected language via the host processor” do not produce any real world useful result. Allowing the user to perform said selected transaction does not mean that the selected transaction is actually performed. Allowing merely provides the ability to the user to perform a transaction but does not necessarily result in the user performing the transaction. Hence there is no real world useful result produced by implementing the steps of the claimed invention.

For an invention to produce a “concrete” result, the process must have a result that can be substantially repeatable or the process must substantially produce the same result again. In re Swartz, 232 F.3d 862, 864, 56 USPQ2d 1703, 1704 (Fed. Cir. 2000) (where asserted result produced by the claimed invention is “irreproducible” claim should be rejected under section 101). The opposite of “concrete” is unrepeatable or unpredictable. The steps of the claim including “allowing the user at the local terminal to perform said selected transaction

interactively in said selected language via the host processor” does not produce useful, concrete and tangible result. Allowing merely provides the ability to the user to perform a transaction but does not necessarily result in the user performing the transaction.

Also in claims 1-27, it is not clear what useful, concrete and tangible result is produced if the condition “if a non-local user account type is identified, establishing a real-time interactive session directly between the user at the local terminal and a host processor” is not satisfied.

There is no useful, concrete and tangible result produced from implementing the steps of the claimed invention. The dependent claims are rejected for the same reason and by way of dependency on a rejected independent claim.

***Claim Rejections - 35 USC § 112***

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

6. Claims 1-27 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1 and 27 recite the limitations “allowing a user to access a local terminal” and “allowing the user at the local terminal to perform said selected transaction interactively in said selected language via the host processor”. It is not clear what the outcomes of these steps are. These are not positive recitations because “allowing” does not imply that the act is performed but only that the user has the capability to do so. For instance allowing a user to access a local terminal does not necessarily result in a user accessing a local terminal. Appropriate correction/clarification is required. Claims 2-26 are rejected by dependency.

Claims 1 and 27 recite the limitations “receiving the user’s selection of a language”, “receiving the user’s input of said access code” and “receiving the user’s selection of a transaction”. These limitations have no antecedent basis. Specifically the steps of the user selecting a language, the user inputting an access code and the user selecting a transaction have not been positively recited in the preceding steps. Appropriate correction/clarification is required. Claims 2-26 are rejected by dependency.

Also in these claims it is not clear as to what is the relationship between the steps of “allowing a user to access a local terminal” and “identifying a type of user account”. Is the second step based on the first step or is the identifying step performed independent of a user accessing the terminal. Similar structural relationship relating the steps/elements of the claim are missing in these claims. Also it is not clear as to what happens if a non-local user account type is not identified. Is the step of “automatically presenting a list of language options” performed regardless of whether a non-local user account type is identified or not identified. Appropriate correction/clarification is required.

Claims 1 and 27 recite in the preamble “A method/system for a user to obtain international account products access on a network”. However there is no mention of any international account products in the body of the claim. It is not clear how the objective set forth in the preamble is accomplished by the body of the claim. Appropriate correction/clarification is required. Claims 2-26 are rejected by dependency on a rejected independent claim.

### **Conclusion**

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

(a) Drummond et al. (US Patent 6,289,320 B1) (September 11, 2001) Automated Banking Machine Apparatus and System.

(b) Hu (US Patent 6,990,466 B1) (January 24, 2006) Method and System for Integrating Core Banking Business Processes.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dr. Narayanswamy Subramanian whose telephone number is (571) 272-6751. The examiner can normally be reached Monday-Thursday from 8:30 AM to 7:00 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin can be reached at (571) 272-6747. The fax number for Formal or Official faxes and Draft to the Patent Office is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PMR or Public PAIR. Status information for unpublished applications is available through Private PMR only. For more information about the PMR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Dr. N. Subramanian  
May 30, 2006